

Application No. 10/774,222

Atty Docket: CB-16

REMARKS**General Comments:**

Applicant has amended claims 1, 23, 31, 34, 41, 43, and 47. Also, Applicant has cancelled claim 22 and added new claim 53. Regarding the Section 112 rejections, Applicant has amended claims 31, 34, and 41 as suggested in the Office Action. Reconsideration and withdrawal of the Section 112 rejections is respectfully requested.

Rejections Under 35 U.S.C. §102:

According to the Office Action, claims 1, 6, 8, 9, 10, 13-15, 20-23, 27, 30, 34, 40, 42-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,558,382 to Jahns et al (hereinafter "Jahns").

Applicant has amended the subject claims and respectfully submits the claims are not anticipated by Jahns. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claim 1 recites a claim limitation that is not found in Jahns. In particular, claim 1 now recites that the temperature indicating element is a discrete section and is axially proximal to the active electrode. Jahns does not disclose this claim limitation.

In contrast, Jahns discloses elongate flexible electrodes (22, 42) that axially overlap the temperature sensitive element 36. The arrangement in Jahns is thus different than that claimed by Applicant. Reconsideration and withdrawal of claim 1 is therefore requested.

Regarding claim 34, Applicant has amended the claim to recite an energy delivery return element and that the energy delivering elements deliver plasma. Jahns does not disclose this claim limitation. Accordingly, reconsideration and withdrawal of the rejection of claim 34 is requested.

Based on the foregoing, Jahns lacks a claim limitation and does not properly anticipate Applicant's claimed invention.

The other claims rejected in the above rejection depend from claim 1, 34 or a claim depending thereon. Accordingly, withdrawal of the rejection of all claims under Section 102 is requested.

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Rejections Under 35 U.S.C. §103:

According to the Office Action, claims 2, 3, 7, 8, 17, 29, 32 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jahns in view of the teaching of Truckai et al. (2003/0216732).

An Office Action must establish a *prima facie* case of obviousness in order to reject claims under 35 U.S.C. § 103. To establish a *prima facie* case of obviousness, at least three basic criteria must be met: 1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j).

In the instant case, no combination of the prior art references teach all claim limitations. In particular, neither Jahns or Truckai teach a device having a temperature indicating element discrete and proximal to an active electrode as recited in claim 1. Additionally, in connection with claim 35, neither reference teaches a device that may provide a plasma as recited in independent claim 34.

Based on the foregoing, Applicant requests reconsideration and withdrawal of the rejections of the claims based on Jahns in view of Truckai.

Rejection under 35 U.S.C. §103 based on Willink in view of Truckai

According to the Office Action, claims 1-3, 6-10, 13-15, 17, 20-23, 27, 29-34, 40-47, and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,254,600 to Willink et al. (Willink) in view of the teaching of Truckai. The Office Action states that the "various configurations for providing the thermochromic material (i.e. an annular band) to provide ease of visualization is deemed to be an obvious design consideration for one of ordinary skill in the art." Office Action at page 6.

Applicant has amended claim 1 to recite that a temperature indicating element is discrete and positioned axially proximal to the active electrode. Applicant has amended claim 34 to recite that at least a portion of the temperature indicating means is positioned between the active and return electrode neither of which neither are suggested in the cited references.

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The mere fact that references can be combined or modified, however, does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Moreover, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. See MPEP § 2143.01. As such, there must be something specific in the prior art that suggests the combination for the Office Action to establish a *prima facie* case of obviousness.

In view of Applicant's current amendment to the claims to define a discrete temperature indicating element positioned axially proximal to the active electrode, Applicant submits the cited references do disclose or suggest this resultant combination. There is no suggestion in the cited references to provide a temperature indicating element in the specific location that Applicant claims. In a sense, Applicant has positioned the temperature indicating material in a surprising location, i.e., spaced away from the target tissue as opposed to as close to the target tissue as possible.

Based on the foregoing, reconsideration and withdrawal of rejection based on Section 103 is requested.


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CLOSING COMMENTS

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224. Should a fee be required in connection with this application the Commissioner is authorized to charge Applicant's deposit account no. 50-0359.

Respectfully submitted,


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